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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,518	06/19/2001	Thomas M. Luebke	380201.91136	2551

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EXAMINER

PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/884,518	<b>Applicant(s)</b> LUEBKE, THOMAS M.	
	<b>Examiner</b> William M Pierce	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**WILLIAM M. PIERCE**  
**PRIMARY EXAMINER**

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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#### **DETAILED ACTION**

##### ***Claim Rejections - 35 USC § 112***

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Amendments made to claim 1, more positively set forth the scope of the claims as being drawn to an "accessory" implying the combination of the drill is not required. However, the claims still positively refers to "the drill housing. Applicant should refer to the drill using inferential language such as "a drill".

##### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hubscher as set forth in the previous office action.

##### ***Claim Rejections - 35 USC § 103***

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hibbard and further in view of Heger for the reasons set forth in the previous office action.

##### ***Response to Arguments***

Applicant's arguments filed 11/4/02 have been fully considered but they are not persuasive.

As to claim 1, Applicant argues examiner's interpretation of element 15 as being "flat". Examiner's interpretation is based on the section view of Hubscher's fig. 1. Fig. 2 does nothing to define surface 15 as anything other than "flat" since it merely shows a cross-section taken along II-II of fig. 1. The functional limitations of "for use with a drill" and "for probing across a wall surface" fail to distinguish over the prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Hubscher clearly shows an "accessory" as called for in claim 1. The intended use for it to be slid across the wall or for use with a drill do not distinguish the claim from the applied art. To the extent that applicant's arguments infer that Hubscher is not "capable" of being slide across a wall is inconclusive. Portion 15 can be slid across a wall at a distance out of contact with the wall. Even if the claim were amended to recite the implication that the surface is in contact with the wall, such would not distinguish over Hubscher since other surfaces of the housing 15, such as that in the area of reference 55 as shown in fig. 1, are capable of sliding along a wall while in contact therewith.

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As to Hibbard and Heger, applicant's argues against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Subsurface locators are known to be used in combination when drilling into a wall. This is the intended purpose of such devices. Such a teaching is clearly not from applicant's disclosure. Hibbard shows attaching accessories used in combination with a drill to its housing. Heger teaches what is known as discussed above, that surface locators used in combination with drills are known. The examiner has extensive personal experience with both a stud finder and a drill in applications such as installing wall anchors for shelves. The use of these tools together in combination as being known to the prior art has little room for argument. . Further one must consider such is a matter of common knowledge and common sense of the person of ordinary skill in the art to design a table that is bigger where more room is needed. (See *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Additionally, one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962).

The argument that a subsurface object locator would have "difficulty in mounting to a drill" is unpersuasive. One skilled in the art would clearly be able to determine shapes necessary to attach two devices in a compatible way. Note that skill is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Applicant alleges that he has solved a problem with interference between the drill and the subsurface locator (i.e. the electric motor interfering with the electronics of the locator). However, this recitation on pg. 6 only refers to the addition of plates 75 and 71 only to the subsurface locator. This design has nothing to do with the combination of the subsurface locator with the drill. Moreover, in applicant's invention each device is to be detached and used separately as they were intended. No interference would occur between each device since they are to be used separately.

New claims 12-16 calls for the design of the attachment means. Where Hibbard shows the use of Velcro, it is clear that other know removably attaching means are known. To have chosen an alternate design to attach the drill in accessory would have been an obvious matter of replacing one known expedient for that of another. As set forth above, skill presumed by those in the art. Applicant has not shown where his attachment choice solves any particular problem or produces any unexpected results.

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**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov) or at telephone number (703) 308-3551.

Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is [Customerservice3700@uspto.gov](mailto:Customerservice3700@uspto.gov).

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.

  
**WILLIAM M. PIERCE**  
**PRIMARY EXAMINER**